REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-68 are pending in this application; with Claims 34-58, 63, 66, and 69 having been withdrawn; and Claims 1, 9, 10, 17, 26, 27, 59, 61, 64, 65, 67, and 68 having been amended. Support for amended Claims 1, 9, 10, 17, 26, 27, 59, 61, 64, 65, 67, and 68 can be found, for example, in the original claims, drawings, and specification as originally filed.[1] Applicants respectfully submit no new matter has been added.

In the outstanding Office Action, Claims 1-33, 59-62, 64, 65, 67, and 68 were rejected under 35 U.S.C. § 103(a) as unpatentable over Wolff (U.S. Patent No. 5,848,413) in view of Arai et al. (U.S. Patent Publication No. 2001/0025311; hereinafter "Arai").

In response to the rejection of Claims 1-33, 59-62, 64, 65, 67, and 68 under 35 U.S.C. § 103(a) as unpatentable over Wolff in view of Arai, Applicants respectfully submit that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claims 1 and 17 are directed to an image forming device, including, *inter alia*:

> ... an operation control part controlling an execution of
> a predetermined operation to be performed on the document
> according to the operation requirement selected by said
> operation requirement selection part.

Wolff and Arai, taken alone or in proper combination, do not disclose or suggest this element of amended Claim 1.

Page 5 of the outstanding Official Action acknowledges that Wolff fails to "disclose an operation control part controlling an execution of a predetermined operation according to

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[1] See original Claims 8 and 25, Figure 38, and the specification at page 32, line 2-21.

the operation requirement selected by said operation requirement selection part." In an attempt to cure the above feature, the outstanding Office Action cites Arai. However, Arai fails to teach or suggest "an operation control part controlling an execution of *a predetermined operation to be performed on the document* according to the operation requirement selected by said operation requirement selection part," as recited in Applicants' amended independent Claims 1 and 17.

Arai describes processing sequences for access control that can prevent access to read or write to a file. Figure 7 of Arai shows a processing sequence for a file I/O hook routine incorporated in a file I/O hook program. A server program 109 receives a request from client program 121 and issues a file access to service OS 103 according to the request.[2] The subject name and user name of the file access request source is obtained from a process ID included in a I/O packet 600.[3] The access type 602 is checked and a processing routine corresponding to the access type (file open, file close, file read or write, or file delete or rename) is executed.[4]

Thus, Arai describes access control on data, whereas Applicants' Claim 1 is directed to controlling an execution of a predetermined operation to be performed on the document according to the operation requirement selected by said operation requirement selection part, i.e. control of device operations. Further, in Arai, the reading and writing of a document is one step of access control, the reading and writing is not *a predetermined operation* to be performed on a document. That is, the reading and writing of a document described in Arai is not an operation specified in advance, but rather is just one step of access control.

Accordingly, Applicants respectfully submit that independent Claims 1 and 17 (and all claims depending thereon) patentably distinguish over Wolff and Arai, taken alone or in proper combination.

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[2] See Arai at paragraph [0053].
[3] See Arai at paragraph [0054].
[4] See Arai at paragraph [0055].

Amended independent Claims 59 and 61 are directed to an image forming method, including, *inter alia*, "an operation control step of controlling an execution of a predetermined operation to be performed on the document according to the operation requirement selected by said operation requirement selection step," and are believed to be patentable for at least the reasons discussed above. Amended independent Claims 64, 65, 67, and 68 also recite "an operation control step of controlling an execution of a predetermined operation to be performed on the document according to the operation requirement selected by said operation requirement selection step," and are believed to be patentable for at least the reasons discussed above.

Accordingly, Applicants respectfully request the rejection of Claims 1-33, 59-62, 64, 65, 67, and 68 under 35 U.S.C. § 103(a) be withdrawn.

Moreover, Applicants respectfully submit that Claim 2 further patentably distinguishes over Wolff and Arai, taken alone or in proper combination. The combination of Wolff and Arai do not disclose or suggest the claimed "wherein said operation requirement is a requirement regarding security for said document."

The outstanding Office Action appears to rely on Wolff to describe this element. However, the portion of Wolff cited to in the Office Action (col. 6, lines 50-58) has nothing to do with security. This section merely describes sending an image by fax, and selecting additional documents for retrieval.

Since dependent Claim 2 incorporates the limitations of Claim 1, Claim 2 cannot be considered in isolation. In the context of Claim 1, an operation requirement selection part selects a requirement regarding security for the document according to the identification information. Wolff does not disclose or suggest that the identification information (which the Office appears to equate to a URL) is used to select a requirement regarding security.

Further, <u>Arai</u> does not cure this deficiency in <u>Wolff.</u> <u>Arai</u> does not disclose or suggest

modifying <u>Wolff</u> to use the URL to select a requirement regarding security.

Thus, Applicants respectfully submit that the combination of <u>Wolff</u> and <u>Arai</u> do not

disclose or suggest the claimed "wherein said operation requirement is a requirement

regarding security for said document."

Moreover, Applicants respectfully submit that Claim 14 further patentably

distinguishes over <u>Wolff</u> and <u>Arai</u>, taken alone or in proper combination. The combination of

<u>Wolff</u> and <u>Arai</u> do not disclose or suggest the claimed "wherein said operation requirement

requires embedding a displayable label upon executing said predetermined operation with

respect to said document, said displayable label contains at least authentication data of said

user requesting said predetermined operation, a timestamp upon requesting said

predetermined operation."

<u>Wolff</u> describes including a bar code in images faxed to a user.[5] However, <u>Wolff</u>

does not disclose or suggest that the bar code includes "authentication data of said user

requesting said predetermined operation, and a timestamp upon requesting said

predetermined operation." The outstanding Office Action appears to rely on <u>Arai</u> to cure this

deficiency in <u>Wolff.</u> The outstanding Office Action relies on Fig. 3 and paragraph [0046] of

<u>Arai</u> when rejecting Claim 14. However, this figure and paragraph merely describe a data

structure of an access log. <u>Arai</u> and <u>Wolff</u> provide no explanation, motivation, or apparent

reason why the access log should be included in a displayable label. Further, the outstanding

Office Action provides no explanation as to why the proposed modification should be made.

It is noted that the Supreme Court in the recent *KSR* decision stated

> Often, it will be necessary for a court to look
> to interrelated teachings of multiple patents; the effects of
> demands known to the design community or present in the
> marketplace; and the background knowledge possessed by
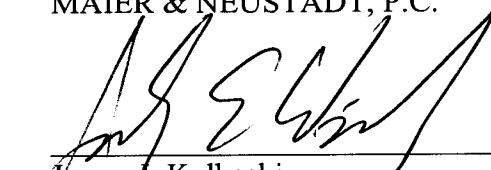
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[5] <u>Wolff</u>, col. 6, lines 46-47.

a person having ordinary skill in the art, all in order to
determine whether there was an apparent reason to com-
bine the known elements in the fashion claimed by the
patent at issue. ***To facilitate review, this analysis should
be made explicit. See In re Kahn, 441 F. 3d 977, 988 (CA
Fed. 2006) ("[R]ejections on obviousness grounds cannot be
sustained by mere conclusory statements; instead, there
must be some articulated reasoning with some rational
underpinning to support the legal conclusion of obvious-
ness").*** (emphasis added)

Thus, the outstanding Office Action is deficient[6], and must be withdrawn and replaced

by a proper Office Action that addresses each of the pending claims individually and explains

the rationale for rejecting each of them.

Consequently, in view of the present amendment, and in light of the above discussion,

the pending claims as presented herewith are believed to be in condition for formal

allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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[6] Applicants note that the rejections of several dependent claims lack any discussion of why the proposed
modification would be made by a person of ordinary skill in the art. Applicants consider each such rejection to
be deficient for the reasons stated above.